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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,364	07/17/2003	Colin John Blamires	03.028.01	8923

7590 12/11/2006		EXAMINER
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ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _17 July 2003_.
2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-25_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-25_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on _17 July 2003_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
        1. ☐ Certified copies of the priority documents have been received.
        2. ☐ Certified copies of the priority documents have been received in Application No. _____.
        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-25 are pending.

Claim Objections

2.   Claims 1-8 are objected to because of the following informalities:

a.   Regarding claim 1, line 5 of the page, "detecting" should be replaced with

"detect".

Appropriate correction is required.

Drawings

3.   New corrected drawings in compliance with 37 CFR 1.121(d) are required in this

application because the drawings (Figures 1-3) are handwritten and difficult to read. Applicant

is advised to employ the services of a competent patent draftsperson outside the Office, as the

U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are

required in reply to the Office action to avoid abandonment of the application. The requirement

for corrected drawings will not be held in abeyance.

Specification

4.   The use of the trademark WINDOWS PE has been noted in this application. It should be

capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary

nature of the marks should be respected and every effort made to prevent their use in any manner

which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

6.   Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention.

> b.   Regarding claim 25, the claim is directed to a server detecting malware upon a
>
> computer by performing steps, including booting. However, the specification (last 3
>
> paragraphs & Fig. 3) describes the local computer booting and then contacting the server.
>
> Therefore, the specification does not describe the server booting the local computer such
>
> that one having ordinary skill in the art at the time the invention was made could make or
>
> use such a server.

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

8.   Claims 5-6 13-14, 21-22 & 25 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

      c.   Regarding claim 5, it is unclear what effect the firewall has on the claim(s), since

the claim(s) is/are directed to a removable physical media bearing a computer program.

      d.   Regarding claims 6, 14 & 22, the claims contain the trademark/trade name

Windows PE. Where a trademark or trade name is used in a claim as a limitation to

identify or describe a particular material or product, the claim does not comply with the

requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218

USPQ 1020 (Bd. App. 1982). The claims scopes are uncertain since the trademark or

trade name cannot be used properly to identify any particular material or product. A

trademark or trade name is used to identify a source of goods, and not the goods

themselves. Thus, a trademark or trade name does not identify or describe the goods

associated with the trademark or trade name. In the present case, the trademark/trade

name is used to identify/describe a version of the Windows operating system and,

accordingly, the identification/description is indefinite.

      e.   Regarding claim 13, similarly to claim 5, it is unclear what effect the claim has on

the previous claims because the firewall does not change the method of claims 9 and 12.

      f.   Regarding claims 17-24, the claims are directed to a computer, but method steps

rather than components are recited. Therefore the claim appears to belong to more than

one statutory class. This renders the scope of the claim unclear. *For the purposes of this*

Office Action, the preamble is understood to read "A computer comprising a processor configured to perform the steps of:".

g.   Regarding claim 21, similarly to claims 5 & 13, it is unclear what effect the claim has on the previous claims because the firewall does not change the computer of claims 20 and 17.

h.   Regarding claim 25, the claim is directed to a "server computer connected by a network link to a computer detecting malware upon said computer by performing the steps of ...". However, it is unclear whether it is the computer or the server computer that is performing the steps of detecting malware and the steps of booting, loading, downloading and performing malware detection. Further, the claim is directed to a server computer, but method steps rather than components are recited. Therefore the claim appears to belong to more than one statutory class. This renders the scope of the claim unclear. *For the purposes of this Office Action, the preamble is understood to read "A server computer, comprising a storage device storing one or more malware detection files, connected by a network link to a computer comprising a second processor, said second computer detecting malware upon said second computer, said second processor configured to perform the steps of:".* It is noted that this type of claim might be more appropriately recited as a system claim, the system comprising both the computer and server computer.

9.   Any claims rejected under 35 U.S.C. §§102 or 103 below are rejected as best understood in light of the rejections under 35 U.S.C. §112. Further, any claim depending from a claim rejected under 35 U.S.C. §112 is rejected based on that dependency.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11.   Claims 1-3, 7-11, 15-19 & 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,347,375 to Reinert et al. (**Reinert**).

Regarding claim 1, Reinert discloses a removable physical media/CD-ROM (col. 6, line 66) bearing a computer program/bootable virus utility (col. 6, lines 55-56) operable to control a computer to detect malware/viruses by performing the steps of booting said computer with a non-installed operating system/bootable virus utility (col. 6, lines 55-61) read from said removable physical media/CD-ROM (col. 6, line 66) instead of an installed operating system (col. 6, lines 55-61) stored on said computer, loading network support code/communications program for said computer read from said removable media/CD-ROM (col. 7, lines 65-67), downloading from a remote computer/remote computer 54 one or more malware/virus detection files (col. 8, lines 20-25) and performing malware/virus detection upon said computer using said one or more malware/virus detection files (col. 8, line 28).

Regarding claim 2, Reinert discloses wherein said one or more malware detection files include at least one of malware definition data/up-to-date virus signature containing data characteristic of malware to be detected (col. 8, lines 23-25).

Regarding claim 3, Reinert discloses wherein said steps further comprise loading security
management code/communications program (col. 7, lines 65-67) operable to control
downloading (col. 8, lines 20-25).

Regarding claim 7, Reinert discloses an optical disk/CD-ROM (col. 6, line 66).

Regarding claim 8, Reinert discloses the malware to be detected including a computer
virus and data file associated with a malware file (signature) (col. 6, lines 55-56 & col. 8, lines
20-25).

Regarding claim 9, Reinert discloses booting said computer with a non-installed
operating system/bootable virus utility (col. 6, lines 55-61) read from said removable physical
media/CD-ROM (col. 6, line 66) instead of an installed operating system (col. 6, lines 55-61)
stored on said computer, loading network support code/communications program for said
computer read from said removable media/CD-ROM (col. 7, lines 65-67), downloading from a
remote computer/remote computer 54 one or more malware/virus detection files (col. 8, lines 20-
25) and performing malware/virus detection upon said computer using said one or more
malware/virus detection files (col. 8, line 28).

Regarding claim 10, Reinert discloses wherein said one or more malware detection files
include at least one of malware definition data/up-to-date virus signature containing data
characteristic of malware to be detected (col. 8, lines 23-25).

Regarding claim 11, Reinert discloses wherein said steps further comprise loading
security management code/communications program (col. 7, lines 65-67) operable to control
downloading (col. 8, lines 20-25).

Regarding claim 15, Reinert discloses an optical disk/CD-ROM (col. 6, line 66).

Regarding claim 16, Reinert discloses the malware to be detected including a computer

virus and data file associated with a malware file (signature) (col. 6, lines 55-56 & col. 8, lines

20-25).

Regarding claim 17, Reinert discloses a computer/computer 42 (col. 7, line 60)

performing the steps of booting said computer with a non-installed operating system/bootable

virus utility (col. 6, lines 55-61) read from said removable physical media/CD-ROM (col. 6, line

66) instead of an installed operating system (col. 6, lines 55-61) stored on said computer, loading

network support code/communications program for said computer read from said removable

media/CD-ROM (col. 7, lines 65-67), downloading from a remote computer/remote computer 54

one or more malware/virus detection files (col. 8, lines 20-25) and performing malware/virus

detection upon said computer using said one or more malware/virus detection files (col. 8, line

28).

Regarding claim 18, Reinert discloses wherein said one or more malware detection files

include at least one of malware definition data/up-to-date virus signature containing data

characteristic of malware to be detected (col. 8, lines 23-25).

Regarding claim 19, Reinert discloses wherein said steps further comprise loading

security management code/communications program (col. 7, lines 65-67) operable to control

downloading (col. 8, lines 20-25).

Regarding claim 23, Reinert discloses an optical disk/CD-ROM (col. 6, line 66).

Regarding claim 24, Reinert discloses the malware to be detected including a computer

virus and data file associated with a malware file (signature) (col. 6, lines 55-56 & col. 8, lines

20-25).

Regarding claim 25, Reinert discloses a server computer/remote computer 54 (col. 8,

lines 10-11) connected by a network link to a computer/computer 42 detecting malware upon

said computer (col. 8, lines 10-11) by performing the steps of booting said computer with a non-

installed operating system/bootable virus utility (col. 6, lines 55-61) read from said removable

physical media/CD-ROM (col. 6, line 66) instead of an installed operating system (col. 6, lines

55-61) stored on said computer, loading network support code/communications program for said

computer read from said removable media/CD-ROM (col. 7, lines 65-67), downloading from a

remote computer/remote computer 54 one or more malware/virus detection files (col. 8, lines 20-

25) and performing malware/virus detection upon said computer using said one or more

malware/virus detection files (col. 8, line 28).

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

13.   Claims 4-5, 12-13 & 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Reinert**, as applied to claims 1, 9 & 17 above, in further view of U.S. Patent Application

Publication 2003/0149887 to **Yadav**.

Regarding claims 4, 12 & 20, Reinert lacks the connection to the remote computer being

secure. However, Yadav teaches that a compute (NDIS) scanning for potential intrusions uses a

signature database to compare with (¶42) and updates the database with the latest intrusion

signatures by contacting a remote computer/SOC (¶42) over a VPN or SSL connection to . safeguard the updates (¶¶43-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reinert to connect to the remote computer via a secure connection. One of ordinary skill in the art would have been motivated to perform such a modification to safeguard the updates, as taught by Yadav (¶¶42-44).

Regarding claims 5, 13 & 21, Reinert lacks explicitly a firewall. However, as best understood inasmuch as claims 5, 13 & 21 affect the claim, it is inherent that Reinert's communication program's connection (secured, as taught by Yadav) will traverse a firewall.

14.   Claims 6, 14 & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Reinert**, as applied to claims 1, 9 & 17 above, in further view of U.S. Patent Application Publication 2004/0117414 to Braun et al. (**Braun**).

Regarding claims 6, 14 & 22, Reinert lacks wherein the non-installed operating system is a Windows PE operating system. However, Braun teaches that WinPE is a platform that replaces DOS for operating system deployment containing minimum functionality needed to run windows setup, scripts, etc (¶48). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reinert to use the Windows PE maintenance operating system as the platform for the bootable virus utility program. One of ordinary skill in the art would have been motivated to perform such a modification because Windows PE is a known maintenance operating platform with minimum functionality needed to run scripts from a well-known software developer (such as the bootable virus utility program), as taught by Braun (¶48).

Conclusion

15.   The prior art made of record and not relied upon is considered pertinent to applicant's
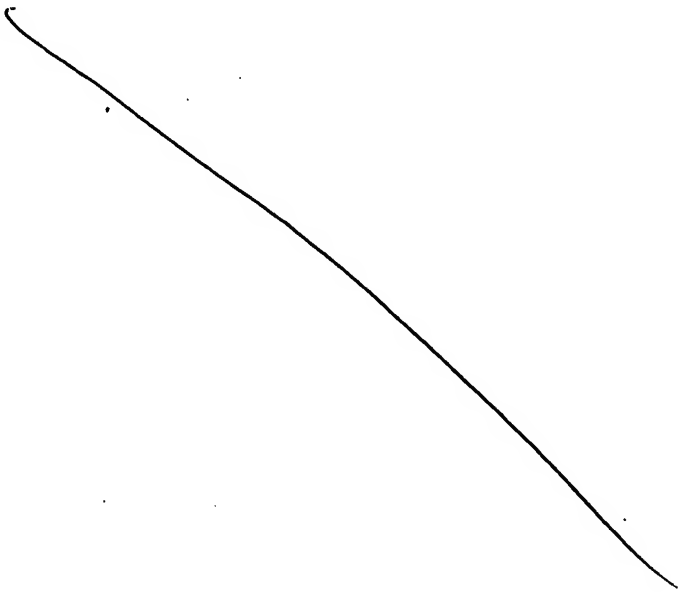
disclosure.

    i.   The Peterson reference is cited for teaching that Windows PE is well known for

VPN's (¶25).

    j.   The Hensley reference is cited for teaching that Windows PE is known for limited

functionality during disaster recover (¶7).

    k.   The Zimmer reference is cited for teaching a pre-boot or during-OS-bootup virus

scanner.

16.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841.

The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the

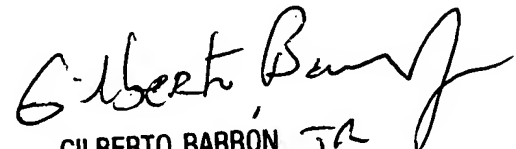organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJS

GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
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November 14, 2006